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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,820	03/31/2004	James Phillip Hollandsworth	030627/274121	5314
826 7590 12/24/2008 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				
EXAMINER DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
12/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,820

Applicant(s)

HOLLANDSWORTH ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2008 has been entered.

Election/Restrictions

2. Newly submitted claims 16 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 16 and 17 are directed to a method of axially adjusting a cutting blade of a slitter device, which has at least one-way patentable distinctness with respect to the device of claim 1; for example, the device can be used in a different manner relative to the method of claims 16-17.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 17 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 6 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by Potter, pn 4,220,064 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Potter, pn 4,220,064 in view of Barnard, pn 46,325 and Corse, pn 3,956,957.

Potter discloses a slitter device (e.g., see Fig. 6A) with every structural limitation of the claimed invention including:

- a first rotatable shaft (e.g., 16) extending axially through a first cutting blade (e.g., 30, 30);

- a second rotatable shaft (e.g., 18) disposed substantially parallel to the first rotatable shaft;

- a second cutting blade (e.g., 32, 32) having the second rotatable shaft extending axially therethrough, the second cutting blade being axially movable relative to the second rotatable shaft;

- a collar (e.g., integrally mounted to the outside of shafts 16, 18) having the second rotatable shaft extending axially therethrough, wherein the collar comprises a radially-outward threaded surface (e.g., with threads 44a) that extends axially through the second cutting blade;

- a first sleeve (e.g., 42) having the collar extending axially therethrough, the first sleeve disposed axially adjacent to a first side of the second cutting blade, the first sleeve comprising a first radially-inward threaded surface (e.g., with outwardly extending thread 44) configured for operably engaging the radially outward threaded surface of the collar such that the first sleeve is axially adjustable relative to the collar; and

- a second sleeve (e.g., a second occurrence of 42) having the collar extending axially therethrough, the second sleeve disposed axially adjacent to an opposing second side of the second cutting blade such that the first sleeve and the second sleeve

cooperate to secure the second cutting blade therebetween, the second sleeve comprising a second radially-inward threaded surface (e.g., with outwardly extending thread 44) configured for operably engaging the radially outward threaded surface of the collar such that the second sleeve is axially adjustable relative to the collar and such that the second cutting blade can be adjusted to maintain a cutting position adjacent to the first cutting blade and in a fixed spaced relation from the first cutting blade so as to compensate for blade wear;

wherein the second cutting blade is rotationally secured to the first sleeve (e.g., as shown in Fig. 7) such that the second cutting blade and the first sleeve are configured to rotate together when axially disengaged from the second sleeve (i.e., the second cutting blade and the first sleeve are fully capable of rotating together when axially disengaged since the rotating shaft will cause both components to rotate to at least some extent);

[claim 6] wherein at least one of the first and second cutting blades is substantially circular in profile (e.g., as understood in the art and by the disclosure);

[claim 14] wherein the axial spacing between the first cutting blade and the second cutting blade is about 0.003 to about 0.005 inches (e.g., the structure of Potter meets such a limitation given the corresponding scale of the device).

In the alternative, if it is argued that Potter does not sufficiently teach or disclose the following limitations:

- a. that the sleeves each lacks a radially inward threaded surface;
- b. a shaft that is separate from the collar and extends through the collar;

- c. circular cutting blades; and
- d. the specific blade spacing;

the Examiner's position is as follows.

Regarding (a), providing threads of various forms is old and well known in the art and to provide one specific known type of thread over another known type of thread would have been a matter of design choice to one having ordinary skill in the art based on usual considerations such as manufacturing considerations. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a thread on the sleeves of Potter for the well known reasons including those described above.

Further, to provide such a threaded sleeve and collar/shaft structure is old and well known in the art and provides various well known benefits including facilitating lateral adjustment of the cutter without removing them from between the sleeves. Barnard discloses one example of such a threaded sleeve and collar/shaft structure. Therefore, it would have been obvious to one having ordinary skill in the art to provide Potter with such a structure to gain the well known benefits including those described above and taught by the prior art.

Regarding (b), it would have been an obvious matter of design choice to modify the integral shaft/collar of Potter by providing separate components since applicant has not disclosed that having such a configuration solves any stated problem or is for any particular purpose, and it appears that the slitter would perform equally well with either configuration.

Further, to provide such a shaft/collar configuration is old and well known in the art and provides various well known benefits including facilitating replacing the threads if worn or otherwise damaged without having to replace the entire shaft, and/or to retrofit slitters with non-threaded shafts. Corse discloses one example of such a separate component shaft/collar configuration. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a configuration on the device of Potter to gain the well known benefits including those described above.

Regarding (c), although Potter does not explicitly disclose that the blades are substantially circular in profile, such blades are the "norm" for such a slitter device as evidenced by much of the prior art made of record. Therefore, it would have been obvious to one having ordinary skill in the art to provide blades that are substantially circular in profile on the device of Potter to gain the well known benefits including continuous positioning of the cutting edge with respect to the workpiece and the cooperating cutter.

Regarding (d), Potter teaches that the number of blades and spacers can be adjusted/manipulated to arrive at a desired blade configuration including blade spacing. Therefore, while it appears that Potter discloses a manipulatable structure that is designed to be configured as desired, and that such a structure is clearly a configuration that is attainable from the disclosed structure, it would have been obvious to one having ordinary skill in the art to provide such a blade spacing to make a desired cut having a corresponding spacing.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Potter, pn 4,220,064.

Potter discloses a splitter device (e.g., see Fig. 6A) with almost every structural limitation of the claimed invention but lacks:

[claim 12] at least one pin extending axially from the first sleeve to engage a corresponding axially-extending aperture defined by the second cutting blade so as to rotationally secure the second cutting blade to the first sleeve.

Herman discloses a slitter device that includes such a pin configuration and teaches that the engagement of the pins and recesses will serve to secure the adjacent components to the shaft with which such components are associated. Therefore, it would have been obvious to one having ordinary skill in the art to provide such pins and recesses on the slitter device of Potter to secure the sleeves to the shaft as taught by Herman.

Response to Arguments

8. Applicant's arguments filed November 24, 2008 have been fully considered but they are not persuasive. As further described in the prior art rejection above, it is respectfully submitted that the prior art teaches and/or suggests the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
December 22, 2008